

REMARKS

Applicant has studied the Office Action dated May 3, 2007. Claims 1-4, 6-14, 17-19, and 21-29 are pending. Claims 1, 6-11, 17, 21, 23, 25, 27, and 29 have been amended. Claims 5, 15, 16, and 20 have been canceled without prejudice. Claims 1 and 17 are independent claims. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Claims

Claims 8, 11, and 27 have been amended to more clearly disclose the invention.

Claims 1 and 17 have been amended to more clearly disclose and distinguish the present invention from the cited reference. Specifically, all of the features of claims 5, 15, and 16 have been incorporated into claim 1. Claim 17 has been amended to incorporate all of the features of claims 16 and 20.

In addition, both amended claims 1 and 17 further recite "the electron switch is formed as a bare chip form which is attached onto one of the ground electrodes by physical bonding using a conductive adhesive." Support for this additional feature can be found at pages 7-8 in the specification as originally filed.

Claims 6, 7, 9, 10, 21, 23, 25, 27, and 29 have been amended to correct dependency in view of canceled claims 5 and 20.

Accordingly, it is respectfully submitted that the amendments have support in the application as originally filed.

§ 102 Rejections

Claims 1-6, 15-20 and 27-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Araki et al. ("Araki" U.S. Patent No. 5,400,039). This rejection is respectfully traversed.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as

recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, claims 5, 15, 16, and 20 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 5, 15, 16, and 20 and it is respectfully requested that the rejection be withdrawn.

In connection with the rejection of claim 6, it is respectfully noted that the Examiner asserts, at paragraph 3 on page 3 of the Office action, that Araki discloses "The inductor is formed as a strip line structure or a spiral structure by a micro electro mechanical system (MEMS) technique (figure 2)." However, it is further respectfully noted that in both Office actions dated December 18, 2006 and May 3, 2007, the Examiner is silent as to disclosure in Araki of the subject matter recited in claim 16, "the inductor is stacked inside the high resistance substrate." Therefore, it is respectfully submitted that the Examiner has failed to establish the requisite "complete identity of invention" with respect to at least claim 16.

It is respectfully submitted that Araki fails to disclose or suggest at least the features newly added to claims 1 and 17, "the electron switch is formed as a bare chip form which is attached onto one of the ground electrodes by physical bonding using a conductive adhesive, and the inductors are stacked inside the high resistance substrate."

Therefore, it is respectfully asserted that independent claims 1 and 17 are allowable over the cited reference. It is further respectfully asserted that claims 2-4 and 6, which depend from claim 1, and claims 18, 19, and 27-29, which depend from claim 17, also are allowable over the cited reference.

§ 103 Rejections

Claim 7-14 and 21-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Araki in view of Ohata et al. ("Ohata" U.S. Pat. No. 6,320,543). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully submitted that Ohata fails to cure the deficiencies of Araki with respect to the features, "the electron switch is formed as a bare chip form which is attached onto one of the ground electrodes by physical bonding using a conductive adhesive, and the inductors are stacked inside the high resistance substrate" as recited in independent claims 1 and 17. It is further respectfully submitted that, notwithstanding that Ohata fails to cure the deficiencies of Araki with respect to the above-discussed features, any modification of the Araki invention by the teachings of Ohata would not produce the present invention.

It is respectfully submitted that Ohata discloses only connection by a bonding wire, but fails to disclose or suggest any type of physical bonding using a conductive adhesive. Therefore, it is further respectfully submitted that Ohata fails to disclose or suggest that "the electron switch is formed as a bare chip form which is attached onto one of the ground electrodes by physical bonding using a conductive adhesive" as in the presently claimed invention. Further, Ohata also fails to disclose or suggest that "the

inductors are stacked inside the high resistance substrate” as in the presently claimed invention.

Therefore, it is respectfully asserted that claims 7-14, which depend from allowable claim 1, and claims 21-26, which depend from allowable claim 17, also are allowable over the cited combination of references.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1-4, 6-14, 17-19, and 21-29 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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